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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/513,365 | 02/25/2000 | Curtis C. Harris | 15280-376100US | 7045 |

7590 10/22/2002

Townsend and Townsend and Crew LLP
Two Embarcadero Center 8th Floor
San Francisco, CA 94111-3834

EXAMINER

NICKOL, GARY B

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1642

DATE MAILED: 10/22/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/513,365

Applicant(s)

HARRIS ET AL.

Examiner

Gary B. Nickol Ph.D.

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7 and 9-57 is/are pending in the application.
- 4a) Of the above claim(s) 10-19 and 22-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,9,20-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Amendment

The Amendment filed June 27, 2002 (Paper No. 16) in response to the Office Action of December 18, 2001 is acknowledged and has been entered.

Claims 1-57 were pending.

Claims 2 and 8 were cancelled.

Claims 10-19, 22-57 have been withdrawn from further consideration by the examiner under 37 CFR 1.142(b) as being drawn to non-elected inventions.

Claims 1, 3-7, 9, and 20-21 are currently under prosecution.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Rejections Maintained.

Claims 1, 3-7, 9 remain rejected under 35 U.S.C. 102(a) as being anticipated by Shimada *et al.* (Cytogenet. Cell. Genet. Vol. 83: pages 232-235, 1988, IDS) for the reasons of record in Paper No. 14, pages 8-9 and for the reasons below.

Applicant's argue (Paper No. 16, page 10) that the Shimada *et al.* reference was not publicly available until well after the earliest effective filing date (February 26, 1999). As proof, applicants offer a date stamped copy of the Shimada *et al.* reference received from the University of California at Berkeley on April 23, 1999. This argument has been considered but is not found persuasive because the date that one educational facility receives a publication can

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vary from country to country or state to state depending upon mail services. For example, the very same reference was received by the National Library of Medicine in Bethesda, MD nearly *two* months before the University of Berkeley (see attached copy of date stamp of 3-16-99 at the end of this action). Due to this unpredictability, and due to the fact that the reference was published in another country and accepted by the journal in October of 1998, it is assumed that the article was received by a member of the public before February 26, 1999. Since it appears that the article was NOT received by a member of the public more than one year before applicant's earliest priority date, this rejection is maintained as a 102(a). Thus, applicants arguments have not been found persuasive, and the rejection is maintained.

Claims 1, 6-7, 9, 20-21 remain rejected under 35 U.S.C. 102(b) as being anticipated by Bonaldo *et al.* (Genbank Database, Accession No. BF523624, as published in Genome Research, Vol. 6, (9), 1996) for the reasons of record in Paper No. 14, pages 9-10.

Applicant's argue (Paper No. 16, page 11) that the Bonaldo *et al.* reference is not an enabling disclosure, and thus, is not prior art. Applicants argue that for an invention such an isolated DNA molecule, a printed publication must include an enabling disclosure. This argument has been considered but is not found persuasive. The intended use of a compound must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. A composition is a composition irrespective of what its intended use is. See In re Tuominen, 213 USPQ 89 (CCPA 1982). As set forth in Paper No. 14, this particular rejection is based on the product *per se* which is clearly anticipated by Bonaldo for the reasons of record. Applicants further argue that the Bonaldo

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reference has a Genbank submission date of 11 Dec 2000 which is well after the earliest priority date of the present application. This argument has been considered but is not found persuasive because the date employed for the rejection was the date of the reference article, 1996. Thus, applicants arguments have not been found persuasive, and the rejection is maintained.

Claims 1, 3-7, 9, and 20-21 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Shimada *et al* for the reasons of record in Paper No. 14, page 11 and for the reasons set forth above. Applicant's arguments regarding the date of accessibility with regards to Shimada *et al.* are not found persuasive and the rejections are maintained. Thus, applicants arguments have not been found persuasive, and the rejection is maintained.

All other rejections and or objections are withdrawn in view of applicant's amendments there to.

No claim is allowed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary B. Nickol Ph.D. whose telephone number is 703-305-7143. The examiner can normally be reached on M-F, 8:30-5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Gary B. Nickol, Ph.D.
Examiner
Art Unit 1642

GBN

October 20, 2002

ANTHONY C. CAPUTA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

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